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Motoi Sato

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JOHN S. PRATT, ESQ

KILPATRICK STOCKTON, LLP

1100 PEACHTREE STREET

ATLANTA, GA 30309

EXAMINER

CHAMPAGNE, DONALD

ART UNIT

PAPER NUMBER

3688

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DELIVERY MODE

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

| | | | |
|------------------------------|--|------------------------------------|--|
| Office Action Summary | Application No. 09/876,666 | Applicant(s) SATO ET AL. | |
| | Examiner Donald L. Champagne | Art Unit 3688 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 June 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-38 is/are pending in the application.
- 4a) Of the above claim(s) 1-14 and 24-38 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 15-17 and 19-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 07 June 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 26 June 2008 has been entered.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 15-17 and 19-23 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. In each independent claim (e.g., at lines 3-4 of claim 15), "information provided by an information provider that is distinct from the advertisement," is new matter of the "negative limitation" kind (MPEP § 2173.05(i)).

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 15-17 and 19-23 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
6. In each independent claim (e.g., at lines 3-4 of claim 15), "information provided by an information provider that is distinct from the advertisement," is indefinite. The phrase can be read as the information provider being distinct from the advertisement, which is certainly

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true, but nonsensical. For purposes of examination, the phrase is assumed to mean that it is the information which is distinct from the advertisement.

Claim Rejections - 35 USC § 102 and 35 USC § 103

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 15-17, 22 and 23 are rejected under 35 U.S.C. 102(e) as being anticipated by Linden et al. (US006266649B1).

10. Linden et al. teaches (independent claims 15, 22 and 23) a method, device and computer readable medium for providing an advertisement, the method comprising:

managing access logs (records of a *user's purchase history*, col. 7 lines 24-33) for accesses (*purchases*) made by users with respect to information provided by an information provider (a *recommendation service*, col. 7 lines 6-8) that is distinct from the advertisement (inherently, para. 12 below), and advertisement information (ads for the *recommended items*, col. 11 lines 54-56) provided by an advertisement sponsor, which is requesting the advertisement providing server to provide the advertisement to selected users of the information provider, (para. 13 below), the advertisement information is to be provided to a client who is a user accessing target information (*items in the user's shopping cart*, col. 10 lines 37-43 and 51) that is provided by the information provider and specified in advance to

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the advertisement providing server by the advertisement sponsor (inherently, since the reference invention operates in real time, col. 10 lines 12-13), where the advertisement information (*the recommended items*) is provided in conjunction with the target information provided by the information provider (*in the user's shopping cart or each item of known interest*, col. 10 line 64-66) and associated with additional information provided by the advertisement sponsor (col. 10 line 66 to col. 11 line 3) that can be accessed by the user client from the advertisement information (col. 11 lines 50-52);

adding access logs of other purchaser users who are advertisement agent virtual users accessing both the product "A" target information and the product "B" additional information (col. 3 lines 1-3);

providing the advertisement on behalf of the advertisement sponsor in response to a request from the client (the client making said request implicitly by adding product "A" to his or her shopping cart, col. 10 lines 39-43), by detecting the advertisement agents as related users who made accesses to the product "A" target information besides the client according to the access logs (col. 3 lines 1-3), extracting the additional information as correlated information that is accessed by the related users according to the access logs (col. 2 line 57 to col. 3 line 1 and col. 10 lines 37-39, col. 10 line 64 to 66), and delivering the advertisement information managed in association with the additional information as extracted, to the client (col. 11 lines 38-39, 49-50 and 54-56), so as to increase an additional information acquisition count for the advertisement sponsor (col. 11 lines 10-13).

For claim 22, Linden et al. also teaches an ad providing server (*Web Server 32*, Fig. 1 and col. 7 line 11).

11. "information provided by an information provider that is distinct from the advertisement": The application does not disclose a distinction between "information" and "the advertisement". In general, "advertising" is recognized in the art as anything that promotes, so any information could be "the advertisement". However, the Office does recognize functional distinctions, and in that sense does accept that "the advertisement" is whatever is delivered by the "advertisement providing server"/*Web Server 32*. "Information" is then whatever is not delivered by the "advertisement providing server"/*Web Server 32*.
12. "advertisement information provided by an advertisement sponsor, which is requesting the advertisement providing server to provide the advertisement to selected users of the

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information provider”: By definition, ad information is inherently provided by an advertisement sponsor. Said advertisement sponsor is inherently “requesting the advertisement providing server to provide the advertisement to selected users of the information provider”. There is no other possible reason why the advertisement sponsor would use the reference invention. The examiner also

13. Linden et al. also teaches at the citations given above claim 17. Linden et al. also teaches claim 16, where the periodic (e.g., *weekly*) updating of the *mappings of items to similar items* (col. 5 line 57 to col. 6 line 2) reads on detecting other related users. The continual accumulation of purchase histories reads on adding access logs of other advertisement agents.
14. Claims 19-21 are rejected under 35 U.S.C. 103(a) as obvious over Linden et al. in view of Yonezawa et al. (US 20030191742A1). Linden et al. does not teach charging an advertisement fee for a minimum advertisement information delivery count. Yonezawa et al. teaches charging an advertisement fee for a minimum advertisement information delivery count (para. [0008]). Because Yonezawa et al. teaches that this enables better management of time-sensitive advertising (para. [0021]), it would have been obvious to one of ordinary skill in the art, at the time of the invention, to add the teachings of Yonezawa et al. to those of Linden et al. Neither reference teaches (claim 21) refunding at least part of the advertisement fee. However, refunding is always an obvious alternative when contract terms cannot be met.

Response to Arguments

15. Applicant's arguments filed with an amendment on 18 September 2007 have been fully considered but they are not persuasive. The arguments have been addressed by the revised rejection. The examiner does wish to offer the following additional comments.
16. Applicant argues (bottom of 14 of 17), “as defined by Claim 15, the advertising sponsor and the information provider are distinct.” The examiner does not see that, and indeed would have maintained the indefiniteness rejection under 35 USC § 112 (para. 5-7 of the Office action mailed on 26 February 2008). The examiner cannot give patentable weight to any distinction between “information provider” and “advertisement sponsor” because it is an ownership distinction and inherently indefinite. If applicant believes that the distinction is

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more than non-functional descriptive material, applicant should appeal this case to the Board of Patent Appeals and Interferences.

Conclusion

17. This is a continuation of applicant's earlier Application No. 09876666. All claims are drawn to the same invention claimed in the earlier application and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the earlier application. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action in this case. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).
18. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.
19. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Donald L. Champagne whose telephone number is 571-272-6717. The examiner can normally be reached from 9:30 AM to 8 PM ET, Monday to Thursday. The examiner can also be contacted by e-mail at donald.champagne@uspto.gov, and *informal* fax communications (i.e., communications not to be made of record) may be sent directly to the examiner at 571-273-6717. The fax phone number for all *formal* matters is 571-273-8300.
20. The examiner's supervisor, Eric Stamber, can be reached on 571-272-6724.
21. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on

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access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

22. **AFTER FINAL PRACTICE** – Consistent with MPEP § 706.07(f) and 713.09, prosecution generally ends with the final rejection. Examiner will grant an interview after final only when applicant presents compelling evidence that “disposal or clarification for appeal may be accomplished with only nominal further consideration” (MPEP § 713.09). The burden is on applicant to demonstrate this requirement, preferably in no more than 25 words. Amendments are entered after final only when the amendments will clearly simplify issues, or put the case into condition for allowance, clearly and without additional search or more than nominal consideration.
23. Applicant may have after final arguments considered and amendments entered by filing an RCE.
24. Applicant is advised that, unless a proposed amendment is filed after final and the examiner returns an advisory action with block 3(a) checked (signifying that further search or consideration is required), an amendment filed with an RCE **COULD BE MADE FINAL IN THE FIRST ACTION** in accordance with MPEP § 706.07(b).
25. **ABANDONMENT** – If examiner cannot by telephone verify applicant's intent to continue prosecution, the application is subject to abandonment six months after mailing of the last Office action. The agent, attorney or applicant point of contact is responsible for assuring that the Office has their telephone number. Agents and attorneys may verify their registration information including telephone number at the Office's web site, www.uspto.gov. At the top of the home page, click on Site Index. Then click on Agent & Attorney Roster in the alphabetic list, and search for your registration by your name or number.

6 September 2008

/Donald L. Champagne/
Primary Examiner, Art Unit 3688